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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,337	09/11/2003	Leslie Mark Ernest	AUS920030409US1	5985

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EXAMINER

BUI, BRYAN P

ART UNIT	PAPER NUMBER
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2153

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/660,337	Applicant(s) ERNEST ET AL.	
	Examiner BRYAN P. BUI	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is responsive to Amendment filed on 01/07/2008 to the original application No. 10/660,337 filed on 09/11/2003.
2. Claims 1-27 are pending of which claims 1, 8, 15 and 21 are independent form.

Response to Amendment

3. The new title of invention "*A Method and A Computer Program Product stored in A Computer Readable Medium for Managing Locally Initiated Electronic Mail Attachment Documents*" has been accepted and entered into the record.

4. The Replacement Sheet of drawings was received on 01/07/2008. However, these drawings are not acceptable because they did not appropriately address all the objections due to the informalities raised in the previous Office action. Accordingly, the drawings are still objected to because of the followings:

. Elements (34) and (22) in Figure 2 have both been used to designate LOCAL AREA NETWORK.

. The drawings do not include the following reference sign(s) mentioned in the description: element 21 (Local Area Network) in Figure 2 and element 40 (CANCEL icon) in Figure 3b.

Response to Arguments

5. Applicant's arguments, see page 10, filed on 01/07/2008, with respect to the rejection(s) of claim(s) 1-27 35 U.S.C. 103(a) as being unpatentable over

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Jones et al. (US Patent Application Publication No. 2002/0120678 A1) in view of Malik (US Pat No. 7,003,551 B2) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Delia et al. (US 2003/0115273 A1).

Claim Objections

6. Claims 1, 7, 8, 15 and 21 are objected to because of the following informalities:

The limitation “an attachment” cited in claims 1 and 8, lines 4 and 5 and in claim 7 line 2 should have changed to “the attachment”. Appropriate correction is required.

The limitation “an electronic mail message” in claims 15 and 21, line 3 should have changed to “the electronic mail message”. Appropriate correction is required.

The limitation “an attachment” cited in claim 15 line 5, and claim 21 line 6 should have changed to “the attachment”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1, 8, 15 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 8 recite the limitation “the storage of attachments” in line 1 and “the original document” in line 7. There is no antecedent basis for those limitations in the claims.

Claims 15 and 21 recite the limitation “the original document” in lines 7 and 8 respectively. There is no antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-7 and 15-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Delia et al. (US 2003/0115273 A1).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any

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invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Delia et al. teaches a method for managing the storage of attachments for electronic mail messages comprising the steps of:

- A) “receiving an electronic mail message at a destination” (see the Abstract: A first email is received at a client computer which includes a first attachment file from the network e-mail system); and
- B) “determining the origin of an attachment to the electronic message”(see Fig. 1A: “compare if two files are identical” (38)).
- C) “deleting an attachment that originated at the destination location of the electronic message” (see Fig. 1C : (62) Deleting the new attachment); and
- D) “creating a link to the original document located at the destination location of the electronic message” (see Fig. 1C : (62) Replace it with a pointer pointing to the existing attachment).

Regarding claim 2, Delia et al. discloses the claimed feature of “the destination location of the electronic message is the location of the sender of the electronic message” (see paragraph [0031]: the incoming file and attachment). It is noted that Examiner considers the incoming file comes from the sender.

Regarding claim 3, Delia discloses the claimed feature of “further comprising before said origin determination step the step of determining whether the received electronic message has an attachment”(see Fig. 1A: “Determine whether incoming file with an attachment” (18)).

Regarding claim 4, Delia discloses the claimed feature of “after said attachment deleting step, the step of saving the electronic message” (see Fig. 1C: Saving incoming message (66)).

Regarding claim 5, Jones discloses the claimed feature of “said attachment origin determination step further comprises determining whether the attachment was created at the location of the sender of the electronic message”(see paragraph [0031]: The attachment management utility to search for existing attachments and compare the existing attachments to the incoming attachment).

Regarding claim 6, Delia et al. discloses the claimed feature of “before said link creation step, the step of updating the received message to reflect the deleted attachment”(see Fig. 1C: step (70)) .

Regarding claim 7, Jones discloses the claimed feature of “before said attachment origin determination step, the step of determining whether the recipient of an electronic message desires to save the electronic message” (see Fig. 1A:Save incoming attachment (42)).

Regarding claims 15-20, they are directed to “A computer program product” corresponding to method claims 1-7. Since they do not teach or define

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above the information in the corresponding method claims, they are rejected under same basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8-14 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delia et al.(US Patent Application Publication No. 2003/0115273 A1) in view of Dunn (US Patent Publication Application No. 2004/0034688 A1).

Regarding to claims 8 and 9, most of the limitations of those claims have been noted in the rejection of claim 1. However, Delia does not expressly disclose the claimed features of “determining whether the electronic mail recipient desires to modify an attachment that originated at the destination location of the electronic message”(as in claim 8) and “further comprising after said modification determination step, the step of modifying the attachment”(as in claim 9). Dunn, from the same or similar field of endeavors, discloses when users desire to modify, forward, resend, etc., the attachment, links to the attachment are provided with an email message (see Dunn, the Abstract). Dunn further

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teaches that an access interface is provided to allow a recipient of a link to a document to view and otherwise obtain the document and to perform operations on the document (see Dunn, also the Abstract). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Delia' method by adding the teachings of Dunn to achieve the claimed features of "determining whether the electronic mail recipient desires to modify an attachment that originated at the destination location of the electronic message"(in claim 8) and "further comprising after said modification determination step, the step of modifying the attachment"(as in claim 9). Such combination would have permitted Dunn's method to allow Delia's method to avoid the problems or undesirable effects which can exist in email system due to proliferation of multiple copies of email attachment, lack of attachment management options or other causes (see Dunn, paragraph [0013]).

Regarding claim 10, most of the limitations of the claim have been noted in the rejection of claim 8. In addition, claim 10 is similar in scope with claim 3, therefore is rejected as set forth above.

Regarding claim 11, Delia does not disclose the claimed feature of "further comprising after said modification determination step, the step of deleting the attachment when there is a determination that the recipient does not want to modify the attachment". Dunn, from the same or similar field of endeavors, teaches that a sender can update or delete an attachment if there was a mistake

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in attaching the wrong object (see Dunn, paragraph [0049]). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Delia's method by adding the teachings of Dunn to achieve the claimed feature of "further comprising before said link creation step, the step of updating the received message to reflect the modified attachment". Such combination would have permitted Dunn's method to allow Delia's method to avoid the problems or undesirable effects which can exist in email system due to proliferation of multiple copies of email attachment, lack of attachment management options or other causes (see Dunn, paragraph [0013]).

Regarding claim 12, most of the limitations of the claim have been noted in the rejection of claim 8. In addition, claim 12 is similar in scope with claim 5, therefore is rejected as set forth above.

Regarding claim 13, Delia does not disclose the claimed feature of "further comprising before said link creation step, the step of updating the received message to reflect the modified attachment". Dunn, from the same or similar field of endeavors, teaches that although a local copy of Doc1 must be obtained at client2, at some point, such as upon saving a modified version of the document, eventually the server's copy of Doc1 is updated to a newer version (see Dunn, paragraph [0045]). Dunn further discloses prior email messages that referenced an older version of the single copy are updated so that they point to the latest version (see Dunn, paragraph [0047]). Thus, it would have been obvious to one

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of ordinary skill in the art at the time the invention was made to modify Delia's method by adding the teachings of Dunn to achieve the claimed feature of "further comprising before said link creation step, the step of updating the received message to reflect the modified attachment". Such combination would have permitted Dunn's method to allow Delia's method to avoid the problems or undesirable effects which can exist in email system due to proliferation of multiple copies of email attachment, lack of attachment management options or other causes (see Dunn, paragraph [0013]).

Regarding claim 14, most of the limitations of the claim have been noted in the rejection of claim 8. In addition, claim 14 is similar in scope with claim 7, therefore is rejected as set forth above.

Regarding claims 21-27, they are directed to "A computer program product" corresponding to method claims 8-14. Since they do not teach or define above the information in the corresponding method claims, they are rejected under same basis.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Gong (US Pat App Pub No. 2004/0064733 A1)

Daniell et al. (US Pat App Pub No. 2004/0068545 A1)

Kirsch (US Pat App Pub No. 2004/0177120 A1)

Mastrianni (US Pat App Pub No. 2002/0116641 A1).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Bui whose telephone number is (571)-270-1981. The examiner can normally be reached on Monday-Friday from 8:00 am to 5:00 pm (EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571)-272-3949. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://paired.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

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would like assistance from USPTO Customer Service Representative or access to the automated information system, call 1-(800)-786-9199 (in U.S.A or Canada) or 1-(571)-272-1000.

BB

/Glenton B. Burgess/

Supervisory Patent Examiner, Art Unit 2153